

### **REMARKS**

This Amendment and Response is fully responsive to the non-final Office Action mailed July 7, 2009 ("Office Action"). By these amendments, Claims 1-3, 8-9, 13, 16-18, 23-24, 30-32, 34-39, 40-41, and 44 have been amended; Claims 4 and 19-22 have been cancelled; and claims 45-51 have been added. After entry of these amendments, Claims 1-3, 8-9, 11, 13, 15-18, 23-24, 28 and 30-51 remain pending. Applicants respectfully submit that no new matter has been added by the foregoing amendments, and that support can be found in the specification as originally filed. In view of these amendments and remarks, Applicants respectfully assert that the rejections are now made moot and reconsideration and allowance of the application is respectfully requested.

Initially, Applicants thank Examiner Kim for graciously granting the telephonic interview on September 3, 2009 with Mr. Brian Decker, and for Examiner Kim's time and attention during the interview, as further documented in the Interview Summary mailed on September 9, 2009.

### **Applicants' Response to Examiner's Comments**

In pages 3 and 4 of the Office Action, Examiner identifies various portions of the specification providing example structure supporting various means for elements of independent Claim 44, as well as definitions for certain elements (namely "associating/associated," "lead time," and "partially"). Applicants do not admit that these are the only possible definitions of these elements, and that varying other reasonable definitions may be possible. In light of the specification, the use of the elements in context of the surrounding claim language, the ordinary meaning of the words, other possible dictionary definitions of the words, the understanding of one of ordinary skill in the art, and any other intrinsic and/or extrinsic evidence that may be useful in deducing the meaning of these elements.

### **Claim Rejections Under 35 U.S.C. § 101**

In the Office Action, Claims 1-4, 8, 9, 13, 15, and 30-37 were rejected under 35 U.S.C. § 101 as allegedly being directed toward non-statutory subject matter. Applicants respectfully

refute this rejection, and submit that the claims as previously amended (reciting “wherein the prior steps are performed by one or more payment servicing computers”) do in fact tie each step to a particular machine, as apparently required by the most recent interpretation of 35 U.S.C. § 101 by the Federal Circuit, and are not tied only to “extra-solution activity,” as alleged. Notwithstanding, independent Claim 1 has been amended to recite that the “receiving” and “determining” steps are performed “by a payment servicing computing system comprising one or more computers,” positively reciting another statutory class by which steps of the claims can be performed. Accordingly, independent Claim 1 and, by extension, dependent Claims 3-4, 8, 9, 13, 15, and 30-37 are now clearly directed toward patent eligible subject matter under 35 U.S.C. § 101.

**Claim Rejections under 35 U.S.C. § 112, second paragraph**

In the Office Action, Claims 1-3, 8-9, 13, 15-18, 23-24, 38, 30-32, and 35-44 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Applicants’ responses to each of the numbered paragraphs of the Office Action, (*see* Office Action, pgs. 6-9), are provided below.

Paragraph 20: Applicants have amended independent Claim 1, therefore rendering this rejection moot.

Paragraph 21: Applicants respectfully submit that Claims 2 and 7 as written are definite and satisfy the requirements of § 112, second paragraph, and request that the rejections be withdrawn. Specifically, the phrase “of the type” is not analogous to phrases such as “or the like” or “etc.,” but instead refers to one of the “plurality of types of post-issue event information” as expressly recited in the previous clause of the claim. Accordingly, Claims 2 and 7 are clear on their face, and are not indefinite.

Paragraph 22: Applicants have amended dependent Claims 2-3 and 17-18 to recite “highest priority level relative to the respective priority levels associated with the plurality of types of post-issue event information,” to clarify that “highest priority level” is relative to the recited plurality of priority levels, rendering this rejection moot.

Paragraph 23: Applicants have amended dependent Claims 3 and 8 to recite "receiving the one of the plurality of types," clarifying that it is the post-issue event information of the type (having the highest priority). In light of these amendments and remarks, this rejection is rendered moot.

Paragraph 24: Applicants have amended dependent Claims 4 and 19 to recite "respective," rendering this rejection moot.

Paragraph 25: Applicants respectfully submit that this type of express inclusion of optional claim elements in earlier claims is common practice, and does not render dependent Claims 8 and 23 indefinite. Applicants respectfully submit that Claims 8 and 23 therefore satisfy the requirements of § 112, second paragraph, and request that the rejections be withdrawn.

Paragraph 26: Applicants respectfully submit that dependent Claims 9, 31, and 24 are not contradictory, as claims from which they depend state "one or more" and these claims instead express recite "plurality," which constrain the claim to the "or more" aspect of the parent claims' recitation. This type of claim language is common practice, and does not render dependent Claims 9, 31, and 24 indefinite. Applicants respectfully submit that Claims 9, 31, and 24 therefore satisfy the requirements of § 112, second paragraph, and request that the rejections be withdrawn.

Paragraph 27: Applicants respectfully submit that the language of dependent Claim 9 is clear and does not render the claim indefinite. More specifically, per Claim 9, the payment lead time is based upon at least the average period (and can be based on other things, though not expressly claimed). This language is typical claim practice for showing an interrelation of one element on another, leaving open the option to also be based upon yet other elements. Accordingly, Applicants respectfully submit that Claim 9 is definite and satisfies the requirements of § 112, second paragraph, and request that the rejection be withdrawn.

Paragraph 28: Applicants respectfully submit that Claims 16-19, 23-24, 28, and 38-43 are improperly rejected under § 112, second paragraph, and request the rejections be withdrawn. The claims clearly identify system having a memory, a communications interface, and a processor, and then recite elements that describe how the processor is configured. The claims are directed to a system, and are not directed to two different statutory classes (and are quite

dissimilar from the claims at issue in *Ex parte Lyell*, in which the claim recites “a workstand” and its structural components followed by “the steps of . . . positioning, removing . . .” in a single claim).

Paragraph 29: Applicants respectfully assert that the elements of “predetermined depositing adjustment period” and “predetermined settlement adjustment period” are clear and definite on their face, and need no further clarification or recitation of additional steps. Accordingly, Applicants respectfully submit that Claims 31 and 39 therefore satisfy the requirements of § 112, second paragraph, and request that the rejection be withdrawn. If the Examiner disagrees, Applicants request the Examiner provide support in a controlling authority for the proposition stated.

Paragraph 30: Applicants have amended dependent Claim 40 to recite “the payment to the payee,” clarifying “payment,” and rendering this rejection moot.

Paragraph 31: Applicants respectfully assert that the element “an immediate payment and posting option” is clear and definite on its face – referencing a type of payment option that can be performed. Accordingly, Applicants respectfully submit that Claim 34 is definite and satisfies the requirements of § 112, second paragraph, and request that the rejection be withdrawn.

Paragraph 32: Applicants have amended dependent Claim 36 to recite “an account number of the payor, wherein the account number is also associated with the payee,” rendering this rejection moot.

Paragraph 33: Applicants respectfully traverse the rejection of independent Claim 44 under § 112, sixth paragraph, reasserting the remarks regarding Claim 44 and the supporting structure in the Amendment and Response filed on April 29, 2009. Moreover, this rejection contradicts the Examiner’s comments in the Office Action on pages 3 and 4. in which the Examiner apparently experiences no difficulties identifying supporting structure in the specification as originally filed. Accordingly, Applicants respectfully request this rejection be withdrawn.

**Claim Rejections under 35 U.S.C. § 112, first paragraph**

In the Office Action, Claims 1-4, 8-9, 13, 15-19, 23-24, 28, and 30-44 were rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement. Applicants' responses to each of the numbered paragraphs of the Office Action. (*see* Office Action, pg. 10), are provided below.

Paragraph 37: Independent Claims 1, 16, and 44 have been amended to recite "same payment mechanism," which is clearly supported by the specification as originally filed. (*See* Application, para. [0217]). Applicants respectfully submit that that this rejection is therefore rendered moot.

Paragraph 38: Applicants have amended dependent Claims 35 and 36 in a manner similar to that in Claim 41, rendering this rejection moot.

Paragraph 39: Applicants respectfully submit that this rejection does not have proper foundation under § 112, first paragraph. Moreover, the element complained of has proper support and is sufficiently clear and definite in light of the previously recited "processing" step in the same or earlier respective claims. Accordingly, Applicants respectfully request that this rejection be withdrawn.

Paragraph 40: Applicants respectfully submit that the element "receive an identification of the payee prior to transmitting the user interface" has sufficient written support in the specification as originally filed, considering at least paragraph [0040], (e.g., "[e]lectronic bill presentment can be via any one of several electronic user interfaces . . ."), in combination with paragraph [0217] and Figure 7, (e.g., "[a]t step 700 a service provider processor 303 identifies a payee and a payment mechanism.>"). Accordingly, Applicants respectfully request that this rejection be withdrawn.

Paragraph 41: Applicants respectfully traverse this rejection, and submit that the specification as originally filed includes sufficient structure suitable for supporting the element of "means for associating the payment lead time with the payee," as required under 35 U.S.C. § 112, paragraph six. An example of structure supporting the "means for associating . . ." is provided by the processor(s) 303, memory(ies) 305, and data repository 310 of Figure 3. Algorithms and step-by-step processes describing example implementations of performing such a determination are illustrated in Figure 7 and the supporting description at paragraphs [0208]-[0232]. (*See*

*Aristocrat Technologies Australia Pty Ltd. v. International Game Technology*, 543 F.3d 657, 86 USPQ2d 1235 (Fed. Cir. Sept. 22, 2008)). Accordingly, Applicants respectfully request this rejection be withdrawn.

**Claim Rejections under 35 U.S.C. § 103**

In the Office Action, Claims 1-4, 8-9, 13, 15-19, 23-24, 28, and 30-44 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Applicants' Background ("Background") in view of U.S. Patent Application No. 2003/0055783 to Cataline et al. ("*Cataline*").

Applicants have hereby amended each of the independent claims to further clarify the distinctions of the claims over the cited art. Specifically, by example, Claim 1 has been amended to include the features of:

storing information identifying a payment issue time of each of one or more payments to a payee, wherein each of the one or more payments have a same form of payment mechanism;

receiving post-issue event information, by a payment servicing computing system comprising one or more computers, associated with each of the one or more payments, wherein the post-issue event information includes at least one of posting information or deposit information received from the payee for each of the one or more payments;

determining a payment lead time, by the payment servicing computing system, based upon the stored information and the respective post-issue event information for at least a subset of the one or more payments, to complete a future payment to the payee issued on behalf of a payor . . . .

(Underlining supplied). As amended, Claim 1 clearly recites a process of "determining a payment lead time . . . to complete a future payment to [a given] payee" based upon a payment issue time and post-issue event information associated with each of one or more historical payments to that payee. By these amendments, "post-issue event information" has been clarified to include "at least one of posting information or deposit information received from the payee." Independent Claims 16 and 44 have been similarly amended.

Applicants respectfully submit that the Background section of Applicants' application fails to teach, suggest, or render obvious the claimed invention. In fact, the Background describes the deficiencies of prior systems, which the claimed invention overcomes in manners previously not achieved. More specifically, independent Claim 1 as amended now recites that payment lead time can be determined based on post-issue event information that includes "posting information" or "deposit information," and which is "received from the payee." Previous systems described in the Background do not receive information from a payee regarding payment, and therefore have no mechanism to determine payment lead times for a specific payee based on information from that payee. Example past systems may have, at best, predicted a standard lead time (and possibly one for electronic payments and one for non-electronic payments) for all payees. (See, e.g., Background, para. [0049]). As described in Applicants' Specification, posting date and deposit date information from each payee are the most accurate information for determining payment lead times for each payee, (see, e.g., Specification, para. [0208]), which were not previously available until Applicants' claimed invention. Accordingly, the Office Action fails to show any references that teach, suggest, or render obvious each of the claimed features.

In alleging that one skilled in the art would have recognized a predictable result of determining a payment lead time based on payment issue time and post-issue event information. (Office Action, pgs. 11-12), Applicants respectfully submit that the Office Action fails to state a *prima facie* case of obviousness under 35 U.S.C. § 103, and therefore the rejection is improper. The Office Action fails to sufficiently show a teaching or suggestion of all claim limitations in the prior art, therefore not satisfying the obligation to state a *prima facie* case of obviousness. (See MPEP § 2143.03 (requiring "all claim limitations must be taught or suggested by the prior art" and citing *In re Royka*, 490 F.2d 981 (CCPA 1974)). Specifically, the Office Action fails to find (and admits that the cited art does not disclose, (see Office Action, pg. 11)) any teaching or suggestion of at least the elements of "determining a payment lead time . . . based upon the stored information and the respective post-issue event information," where "the post-issue event information includes at least one of posting information or deposit information received from the payee for each of the one or more payments," as recited by amended Claim 1. In fact, none of the

cited references teach or suggest transmitting post-issue event information from a payee to a payment servicing computer, and thus necessarily do not teach or suggest determining a payment lead time for that payee based on that information.

Where the Office Action attempts to take Official Notice of this feature, (*see* Office Action, pgs. 11-12 (although the Office Action does not assert Official Notice, the Office Action admits that the cited references fail to disclose this feature and does not cite to any other reference)), Applicants respectfully submit that the Official Notice improperly alleges common knowledge that is not well-known and cannot be readily supported by evidence. Official Notice is to be “judicially supplied,” and “should only be taken by the Examiner where the facts asserted to be well-known . . . are capable of instant and unquestionable demonstration of being well-known.” (MPEP § 2144.03(A) *citing In re Knapp Monarch Co.*, 296 F.2d 230 (CCPA 1961)). “[A]ssertions of specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art.” (MPEP § 2144.03(A) *citing In re Ahlert*, 424 F.2d 1088 (CCPA 1970)). Moreover, if an Official Notice is relied upon, “the Examiner must provide specific factual finding predicated on sound technical and scientific reasoning to support his or her conclusions of common knowledge.” (MPEP § 2144.03(B) *citing In re Soli*, 317 F.2d 941 (CCPA 1963)).

Here, the Office Action is impermissibly extending its scope of Official Notice, alleging common knowledge of determining payment issue times without citing to *any* reference other than the Applicants’ own Background. In fact, the Office Action actually confuses the standard of demonstrating predictable results, which is typically applied to support a combination of references – here the Office Action has not even shown, and admits to not showing, each of the features in cited references. The act of determining payment lead times as recited in Applicants claims is not the type of information that is capable of instant and unquestionable demonstration, and therefore is improper subject matter for taking Official Notice. If such information was easily demonstrated, then there would be no difficulties identifying one or more prior art references for each of the features which have not yet been identified in the prior art. Moreover, the reasoning applied in the Office Action, (*see* Office Action, pg. 12, para. 45), is conclusory at best, simply re-stating the claimed features without providing the required “factual finding



predicated on sound technical and scientific reasoning.” Accordingly, Applicants respectfully submit that the Official Notice taken is improper, and that the Office Action therefore fails to state a *prima facie* case of obviousness by not providing any teaching or suggestion of each claimed feature in the cited art.

Applicants therefore respectfully submit that none of the cited references, alone or in combination, fail to teach, suggest, or render obvious at least the feature of “receiving post-issue event information . . . , wherein the post-issue event information includes *at least one of posting information or deposit information* received *from the payee* for each of the one or more payments,” as recited in amended independent Claim 1. Moreover, notwithstanding whether post-issue even information is shown to be received from a payee, none of the cited references teach or suggest “determining a payment lead time . . . , based upon the stored information and the respective post-issue event information,” recited in amended independent Claim 1.

*Cataline* also fails to cure any of the aforementioned deficiencies, as explained in the remarks provided in the Amendment and Response filed on April 29, 2009, for example, at pages 21-22. Specifically, *Cataline* relates to systems for determining a way to settle a specific payment request, and only casually mentions “lead time” as one of many variables that can be used to optimize the payment request. However, the casual mention of the word “lead time” does not teach or suggest the features of “receiving post-issue event information,” or “determining a payment lead time . . . , based upon the stored information and the respective post-issue event information,” as recited in amended independent Claim 1.

Accordingly, because the cited references fail to teach, suggest, or render obvious each of the claimed features, as explained above, Applicants respectfully submit that independent Claim 1, as hereby amended, is allowable thereover. Amended independent Claims 16 and 44 each recite similar features as independent Claim 1, and therefore independent Claims 16 and 44 are allowable for at least the same reasons. Furthermore, Applicants state that dependent Claims 2-4, 8-9, 13, 15, 17-19, 23-24, 28, and 30-43 are allowable as a matter of law as depending from an allowable claim, notwithstanding their independent recitation of patentable features.

With respect to select dependent claims, Applicants reassert the remarks provided in the Amendment and Response filed on April 29, 2009 regarding at least dependent Claims 4, 15, 19,

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24, 31, and 39, and submit that the rejections in the current Office Action are traversed for at least those same reasons.

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### **CONCLUSION**

Reconsideration of the Application is requested in light of the amended claims and the remarks. Applicants believe they have responded to each matter raised in the Office Action. Allowance of the claims is respectfully solicited. It is not believed that any extensions of time or additional fees are required beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. §1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 19-5029.

If there are any issues which can be resolved by teleconference call or an Examiner's Amendment, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

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Date: **October 2, 2009**

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Attorney Docket No.: **23952-0142**